

### **REMARKS**

Applicants have carefully reviewed the Office Action dated November 15, 2006. Favorable reconsideration is respectfully requested in light of the above amendments and the following comments. Claims 13, 16, 20, 32 and 34 have been amended to correct a minor grammatical error. No new matter has been added as a result of these amendments.

#### **Drawings**

As an initial matter, there is no indication of acceptance of the formal drawings filed on September 5, 2003 by the Examiner on the Office Action Summary page. Applicants respectfully request that the Examiner indicate whether the drawings are accepted in the next communication from the Office.

#### **Specification**

The Examiner has objected to the Title as not being descriptive. Applicants have amended the Title as suggested by the Examiner. Applicants have also amended the specification to correct minor typographical errors and to update the status of referenced applications. Favorable reconsideration is respectfully requested.

#### **Claim Rejections under 35 USC § 102**

Claims 1-3,5-23,25-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Shireman et al. in U.S. Patent Application Publication No. 200410167442 A1. Applicants respectfully traverse this rejection. In order to anticipate, the cited reference must disclose each and every claimed element. Shireman et al. fail to do so.

In particular, independent claim 1 (and hence claims 2-3 and 5-15 depending therefrom) recites a method of making a medical device in which a structural member including a metallic material is attached to an elongate shaft by heating a discrete portion of the structural member to a temperature that is at or above a melting point of the metallic material. The heated portion is allowed to flow onto a surface of the elongated shaft and is allowed to cool thereon, thereby forming a mechanical bond between the structural member and the elongated shaft.

The Examiner has apparently misinterpreted the cited reference, as it is not appropriate to assert that Shireman et al. disclose a laser soldering embodiment in which a heated portion of a coil is allowed to flow onto an elongated structural member. In soldering, including laser soldering, one of skill in the art will recognize that two distinct elements or parts are joined together by melting a solder, and then permitting the solder to flow into and between the two distinct elements or parts before the solder cools and resolidifies. In soldering, neither of the two elements or parts being joined are melted. Thus, it is not appropriate to assert that Shireman et al. discloses the claimed invention.

Independent claim 16 (and hence claims 17-18 depending therefrom) recite similar elements not shown by Shireman et al., and thus are patentable for at least these reasons. Moreover, claim 16 recites that the mechanical bond is achieved without any fluid intermixing of material from the elongated shaft and material from the structural member. In other words, claim 16 excludes welding. While the Examiner has pointed to Shireman et al. as disclosing soldering, it can be seen that the reference also discloses welding including laser welding. Claims 16-18 are patentable over Shireman et al. for at least the reasons discussed above.

Independent claim 19 (and hence claims 20-21) cites similar limitations to claim 1, except that claim 19 more particularly describes using laser energy to heat a portion of the structural member. Claims 19-21 are patentable over Shireman et al. for at least the reasons discussed above.

Independent claim 22 ( and hence claims 23 and 25-33 depending therefrom) cites similar limitations to claim 16, except that claim 22 describes attaching a tubular member to an elongated core wire to form a guidewire. Claims 22-23 and 25-33 are patentable over Shireman et al. for at least the reasons discussed above.

Independent claim 34 recites a method of making a guidewire in which a tubular member is attached to an elongated core wire without fluid intermixing of material from the core wire with material from the tubular member. One of skill in the art will recognize that claim 34 excludes welding. Moreover, claim 34 states that a mechanical bonding is formed without the use of an additional bonding material. One of skill in the art will recognize that claim 34 excludes soldering. Thus, claim 34 is patentable over Shireman et al. for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

**Claim Rejections under 35 USC § 103**

Claims 1 -3,5-23,25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safarevich in U.S. Patent No. 6,061,595 in view of Omori in Japan Patent No. 58-90,389. One of the requirements of a *prima facie* obviousness rejection is that there must be motivation to combine the references as suggested by the Examiner. At a minimum, this requirement has not been met. Applicants do not concede that the other requirements of a *prima facie* obviousness rejection, i.e., all elements shown and reasonable expectation of success, have been provided.

Safarevich describes traditional welding. The Examiner has recognized this, and thus has relied upon Omori to suggest melting only one of the workpieces. The rationale provided for such a modification is to create a mechanical bond while conserving the energy that would otherwise be used to melt the second workpiece. This rationale is not appropriate.

Indeed, it would seem that making such a modification would substantially change the final product to which Safarevich appears to be directed. If the primary reference is directed to melting a portion of both elements to be joined, i.e., welding, a suggestion by the secondary reference to only melt one element would seem to materially change the function and structure of the device disclosed by the primary reference. It is well established that a modification that significantly changes the primary reference cannot be considered as obvious.

Thus, there can be no motivation to make such a modification. The *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

**Conclusion**

Examination of the above-identified claims is respectfully requested. If a phone conference is believed necessary to resolve any outstanding issues with respect to the above discussion, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,  
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By their attorney,

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